

Amendment
Application No. 09/871,605
Attorney Docket No. 010713

REMARKS

Claims 1, 3-7 and 9-12 are pending in the present application. Claims 1 and 7 are herein amended.

Claim Rejections - 35 U.S.C. §112

Claims 1, 3-7 and 9-12 were rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps.

The Advisory Action acknowledges that the term “operator” in claims 1 and 7 would not be confused with a “computerized logic module.” (Advisory Action, page 2.) However, the Advisory Action states that clarification is required between the “operator” and the applicant who operates the claimed invention.

Claims 1 and 7 have been amended to further distinguish between the “applicant” and the “operator.” Claims 1 and 7 both recite that the human operator is an entity separate from the applicant.

Withdrawal of the rejection is requested.

Claim Rejections - 35 U.S.C. §103

Claims 1, 3-7 and 9-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over **Eisenhart** (U.S. Patent Application Pub. No. 2001/0047276) in view of **Dworkin** (U.S. Patent 6,026,148). Favorable reconsideration is requested.

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A. Human Operator

Applicant respectfully submits that Eisenhart in view of Dworkin does not disclose:

using a human operator, which is an entity separate from the applicant, to select members for which provision of information is to be requested, *by utilization of information about the members registered in the membership database*

as recited in amended claim 1, and

means for a human operator, which is an entity separate from the applicant, to select members for which provision of information is to be requested, *by utilization of information about the members registered in the membership database*

as recited in amended claim 7.

Applicant previously pointed out that in Dworkin, either an electronic operator is used or no operator at all is used. (Amendment, January 17, 2007.) Dworkin discloses that a user, and not an operator, can manually select an expert to direct a question to. Dworkin discloses a computer-based system which facilitates the exchange of information between users and expert respondents. (Abstract.) Dworkin discloses that a user logs on to the system and creates a question to store in the memory of the central computer. (Col. 2, lines 5-7.) An expert respondent is then selected, either *manually by the user* or automatically by the system. (Col. 2, lines 7-10.) Dworkin discloses that the system, or electronic operator as alleged by the Examiner, can be bypassed in order for the user to directly ask an expert a question. Thus, Dworkin discloses that either an electronic operator is used or that no operator at all is used.

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The Advisory Action takes the position that the “user” in Dworkin corresponds to the claimed “human operator.” (Advisory Action, page 2.) However, when viewing Dworkin as a whole, Dworkin does not disclose that the “user” can select respondents in which to direct questions to “by utilization of information about the members registered in the membership database” as recited in claims 1 and 7. Prior art must be considered as a whole, including portions that would lead away from the claimed invention. MPEP § 2141.03(VI) citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983).

Dworkin does not disclose that information about the respondents is available for users in order to decide which respondent or respondents to direct a question to. Dworkin discloses posting a picture and biography of an expert respondent after that respondent has answered the question. (Col. 5, lines 27-29.) However, Dworkin does not disclose allowing a user to view biographical information about expert respondents in order to select whom to direct a question to.

The Advisory Action further takes the position that it is the combination of Eisenhart and Dworkin that discloses that “information is available for users in order to decide which respondent or respondents to direct a question to.” (Advisory Action, page 2.) The Advisory Action states that Eisenhart teaches the step of compiling a list of members according to member information and Dworkin teaches the step of selecting a specific expert respondent. (Advisory Action, page 2.)

When viewing Dworkin as a whole, Dworkin does not disclose allowing a user to view biographical information about expert respondents in order to select whom to direct a question to. If Eisenhart is modified to include the “user” from Dworkin, then the “user” would not be allowed to view the “compiled member information” in Eisenhart since the “user” in Dworkin cannot view information about expert respondents in Dworkin.

Therefore, when taking Eisenhart and Dworkin as a whole, Eisenhart in view of Dworkin does not disclose the elements as recited in claims 1 and 7.

B. No Motivation to Combine Eisenhart and Dworkin

Applicant respectfully submits that one of ordinary skill in the art at the time of the present invention would not have been motivated to combine the teachings of Eisenhart and Dworkin.

Dworkin discloses a computer bulletin board or forum for posting questions in which a respondent expert then answers. (Abstract.) By contrast, Eisenhart is concerned with forming business partnerships. (Eisenhart, paragraph 14.) Eisenhart discloses facilitating collaboration between a technology supplier and a buyer of a technology asset. (Abstract.) Since Dworkin and Eisenhart deal with unrelated and non-analogous technologies, one of ordinary skill art would not have been motivated to combine the references.

Moreover, Dworkin teaches away from using an intricate computer network as disclosed in Eisenhart. Dworkin discloses a disadvantage in the art of computer-based bulletin boards is that

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when one relies on a number of technical experts, these experts must all have some facility with computers, and must be located near a computer, in order to answer questions.

(Col. 1, lines 45-50.) Dworkin discloses solving this problem by

providing a system and method for dissemination of information, especially expert information, wherein the experts providing the information need not be computer literate, and need not be located near a computer.

(Col. 1, lines 59-63.) Specifically, Dworkin discloses solving the problem by providing the expert respondent a way to answer questions by speaking the answer in a telephone. (Col. 2, lines 12-14.) Since Dworkin teaches away from using an intricate computer network as disclosed in Eisenhart, one of ordinary skill in the art would not have been motivated to combine the references.

For at least the foregoing reasons, claim 1 and 7 are patentable over the cited references, and claims 3-6 and 9-12 are patentable by virtue of their dependence from either claim 1 or 7.

Accordingly, withdrawal of the rejection of claims 1, 3-7 and 9-12 is hereby solicited.

In view of the aforementioned amendments and accompanying remarks, Applicant submits that the claims, as herein amended, are in condition for allowance. Applicant requests such action at an early date.

If the Examiner believes that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned attorney to arrange for an interview to expedite the disposition of this case.

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If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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